

REMARKS

The Applicant sincerely appreciates the interview conducted by Examiner Phi D. A with the Applicant's attorney, E. Bradley Gould, on December 16, 2004. The following remarks reflect the discussion during the interview.

Claims 1-3, 5-7, 10, and 12 are presently pending for the Examiner's review and consideration. These claims were rejected in the Office Action under 35 U.S.C. § 103(a) as obvious over Greenway (2,088,238) in view of Taylor *et al.* (3,740,910) and Searer (5,570,554).

Claim 1 is directed to a method for attaching solid hardwood floor planks to a concrete surface. This method provides surprising benefits over any of the art of record, for example in that it allows for greater tolerances in the type and shape of solid wood floorboards that are attached to concrete floor surfaces. Claim 1 defines preparing the solid wood floorboards away from the installation site and applying them to the concrete floor surface with a water-resistant, impermeable adhesive in a sufficient quantity to attach the floorboards. After the adhesive is applied, the boards are nailed to the concrete surface, and the adhesive is allowed to set. Claim 5 structurally defines a floor with the wood floor planks that are attached to concrete subflooring by an adhesive and nails.

Typically, to use any type of adhesive to attach wood flooring directly to concrete, the wood planks need to be very flat to ensure proper and sufficient contact between the floorboards, adhesive, and concrete. This limits the type of preparation of the wood that can be used prior to the adhering. In certain types of wood flooring preparation, especially in certain types that are conducted away from the installation site due to the machines and processes used, the wood planks can end up significantly warped to an extent that it can be very difficult or impossible to produce a strong adhesion to the concrete sub-flooring by merely laying the floorboards on the adhesive. The inventors of the present application invented applying nails to ensure that the wood floorboards are held flat against the concrete surface with the adhesive therebetween to allow the adhesive to set and provide the proper contact.

Obtaining a good contact between the floorboards and concrete and a proper setting of the adhesive is especially important in flooring that is directly

positioned on concrete since water can collect on the concrete, increasing the hydrostatic pressure in the wooden floorboards. This can cause the floorboards to warp and, when using traditional methods, the buildup of hydrostatic pressure causes the wood to peel away from the concrete, ruining the floor.

As discussed during the interview, Greenway teaches using mastic to attach floorboards to concrete, but this is done with out any nails. Greenway teaches the use of nails to nail the floorboard to a wooden sub-flooring, but not when there is a concrete sub-flooring. It is known that nails are not nearly as effective or durable at holding the floorboards to the concrete. Searer, on the other hand, teaches nailing the floorboards directly to concrete, but there is no suggestion or motivation to combine this teaching with the Greenway application with mastic.

This is because Searer teaches away from using any kind of adhesive. The problem overcome by Searer is expressly that the methods of fastening floor members using chemical adhesives can contain toxic or harmful chemical substances. Searer seeks to avoid aeration and other treatments that are used with adhesives and also seeks to eliminate the use of gloves or masks that are employed by individuals laying the flooring surface. (E.g., Searer 1:16-24.) Specifically, Searer teaches that the "primary object of the invention is to provide interlocking floor . . . covering members . . . , whereby the covering members may be attached to the appropriate surface without the use of adhesives . . ." (Searer 2:21-30.) It is thus clear that the Searer disclosure literally and expressly teaches one of ordinary skill in the art not to use adhesives.

The teaching of each of the references used in a rejection must "be considered in its entirety, i.e., as a whole, including positions that would lead away from the claimed invention." (M.P.E.P. § 2141.02.) The disclosure in Searer that specifically teaches away from using adhesives cannot be ignored when proposing a combination with Greenway. It is clear that one of ordinary skill in the art would not have found any motivation to combine Greenway, which uses mastic as an adhesive, with a references that teaches away from using any kind of adhesive. Also, the cumulative teachings of Greenway and Searer are contradictory, and the combined teachings of all of the references still fall short of the claimed invention.

Furthermore, the Taylor reference, while teaching the attachment of two very different materials than wood flooring and concrete sub-flooring, does not remedy the deficiencies of the other references. Taylor discloses a method attaching drywall in a vertical orientation to wall studs. The Taylor teaching is in a non-analogous art to flooring. Constructing flooring involves significantly different problems to be overcome than in attaching drywall to a wall surface, and vice versa. Notably, the problem mentioned above of hydrostatic pressure warping floorboards that are attached on concrete is not at all present in walls. The moisture in the flooring is collected in the wood, while in walls it is allowed to drain vertically due to the vertical orientation of the walls. Additionally, the hydrostatic pressure problem is present within the wood itself of the floorboards due to the water collecting adjacent to the concrete. Such a problem is not present in an extremely dissimilar material such as drywall. Also, only narrow studs and porous insulation is present behind the drywall of Taylor, so there is no mechanism that would possibly collect the water to cause a hydrostatic pressure problem that can cause extreme warping that wood exhibits on concrete. Additionally, drywall is manufactured in very regular and flat sheet sizes, and the problem encountered with certain treatments of floorboards, which leave the floorboards in an uneven, curved condition prior to installation, is not present. Thus, there is no suggestion that the method of Taylor would be of use with these problems extant in flooring material.

Furthermore, while Taylor discloses using an adhesive and nails to attach the wallboard to the studs, this is done for reasons that have no application in laying flooring. Since the drywall is adhered to the studs in a vertical position, naturally the drywall would fall off of the studs before the adhesive sets. The nails are needed because the drywall is in a vertical position. On the other hand, when constructing flooring, gravity does not act to peel the flat wood planks of Greenway away from the sub-flooring. Consequently, there is no suggestion that using nails in addition to adhesives would be helpful with flooring, since the purpose of the nails in Taylor is to resist gravity, it is not applicable when applying floorboards in a horizontal-floor orientation. Finally, since the problem of hydrostatic pressure is not present in the Taylor materials, there is also no motivation to look to the teaching of Taylor to overcome these problems that exist only in flooring, but not when attaching drywall to studs.

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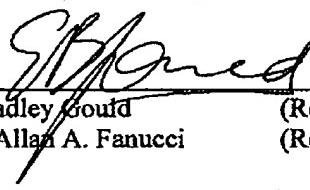
For the above reasons, claims 1 and 5 are patentably distinct from the references.

Further reasons for patentability of the independent claims were also presented in the Request for Reconsideration filed on July 6, 2004, including an explanation of how the adhesives disclosed in the references do not teach or suggest the present invention, and also submitting evidence of the outstanding commercial success of the product constructed by the claimed method. With regard to commercial success, the Examiner has merely chosen to ignore the submitted evidence by stating that commercial success can be based on variety of reasons. Applicants, however, do not have to prove that commercial success is not due to other factors. (M.P.E.P. § 716.03(b), citing *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 7 U.S.P.Q.2d 1222 (Fed. Cir. 1988).) On the contrary, Applicants' submission of evidence in Mr. Hirch's Declaration that shows outstanding commercial success of the product constructed by the claimed method satisfies the burden of proof of establishing a nexus between the claimed invention and the commercial success. See M.P.E.P. § 716.03. Therefore, the argument is not moot, and it is respectfully requested that the Examiner consider the evidence of commercial success.

For these reasons, the entire application is now believed to be in condition for allowance. Should any issues remain, a personal or telephone interview is respectfully requested to discuss the same in order to expedite the allowance of the application.

Respectfully submitted,

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Date


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